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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/671,289	09/25/2003	Theodorus Henricus Gerardus Maria Peters	903-86	1500
23869	7590	06/08/2006		
HOFFMANN & BARON, LLP 6900 JERICHO TURNPIKE SYOSSET, NY 11791			EXAMINER MRUK, GEOFFREY S	
			ART UNIT 2853	PAPER NUMBER

DATE MAILED: 06/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/671,289

Applicant(s)

PETERS ET AL.

Examiner

Geoffrey Mruk

Art Unit

2853

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 April 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8, 10 and 11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8, 10 and 11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 5 April 2006 has been entered.

Claim Objections

Claims 5, 6, and 8 are objected to because of the following informalities:

Claims 5, 6, and 8 use a colon between two components to describe a ratio.

This colon implies a mathematical expression. The examiner suggests replacing each colon with "to" so that the claims are grammatically correct.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 10 and 11 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for containing the phrase “and optionally surfactant, bactericide and/or fungicide”. Both terms “optionally” , “and/or” renders each claim vague and indefinite since one of ordinary skill in the art would not be able to ascertain the metes and bounds of each term “optionally” , “and/or”. Furthermore, the phrase “the ink composition consists essentially of” in claims 10 and 11, further limits claims 1 and 8 respectively, by closing the components that are in the composition. The terms “optionally”, “and/or” in claims 10 and 11 then open the components that could be in the composition. Therefore, for examination purposes, the examiner will examine the following:

Claim 10. (New): “Method according to claim 1, wherein the ink composition consists essentially of dye, water, lower alcohol and humectant”.

Claim 11. (New): “The ink composition according to claim 8, wherein the ink composition consists essentially of dye, water, lower alcohol and humectant.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-6, 8, 10, and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Escano et al. (US 5,614,008).

With respect to claim 1, Escano discloses a method for printing a substrate with ink drops according to the "drop-on-demand" principle (Column 1, lines 6-10), which substrate is provided with a polymeric ink-receiving layer, using an ink jet printing device, the printhead of which is provided with a piezo element for generating ink drops, the method comprising the steps of supplying the substrate (Column 12, lines 60-64), generating ink drops and depositing the generated ink drops on the substrate (Column 12, lines 60-64), wherein the ink from which the ink drops are formed, has an ink composition which comprises a dye (abstract, i.e. colored), water (Claim 1, part D), a lower alcohol (Claim 1, part C) and humectant (Claim 1, part B), wherein the lower alcohol content is 5-30% by weight (Column 21, lines 31-33), and wherein the ink composition has a viscosity greater than 3cP (Column 19, line 33).

With respect to claim 2, Escano discloses the lower alcohol is selected from the group consisting of monohydric alcohols having 1-4 carbon atoms (Column 21, line 33).

With respect to claim 3, Escano discloses the lower alcohol comprises isopropanol (Column 12, lines 29-31).

With respect to claim 4, Escano discloses the humectants comprise one or more polyhydric alcohols, polyethylene glycols, or polypropylene glycols (Claim 7).

With respect to claim 5, Escano discloses the humectant : lower alcohol weight ratio is between 0.10 and 1.50 (Claim 1, parts B and C).

With respect to claim 6, Escano discloses the lower alcohol : water weight ratio is between 0.08 and 0.6 (Claim 1, parts C and D).

With respect to claim 8, Escano discloses the ink composition comprises a dye (abstract, i.e. colored), water (Claim 1, part D), lower alcohol (Claim 1, part C) and humectant (Claim 1, part B), the lower alcohol content thereof being 5-30% by weight (Column 21, lines 31-33), the lower alcohol : water weight ratio being between 0.08 and 0.6 (Claim 1, parts C and D), and wherein the ink composition has a viscosity greater than 3 cP (Column 19, line 33).

With respect to claim 10, Escano discloses the ink composition consists essentially of dye (abstract, i.e. colored), water (Claim 1, part D), lower alcohol (Claim 1, part C) and humectant (Claim 1, part B).

With respect to claim 11, Escano discloses the ink composition consists essentially of dye (abstract, i.e. colored), water (Claim 1, part D), lower alcohol (Claim 1, part C) and humectant (Claim 1, part B).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Escano et al. (US 5,614,008) in view of Kovacs et al. (US 6,139,611).

With respect to claim 7, Escano discloses a substrate (Column 12, lines 60-64).

However, Escano fails to disclose the substrate comprises a polymeric ink-receiving layer made from a swelling polymer.

Kovacs discloses image-recording elements where "Recording elements useful with the composition of the invention comprise a support coated with a subbing layer, a solvent-absorbing layer, and an ink-receiving layer. In the ink-receiving layer, a cross-linkable polymer is used such as gelatin or acetoacetylated poly(vinyl alcohol)" (Column 4, lines 30-34).

At the time of the invention, it would have been obvious to use the image-recording elements disclosed in Kovacs as the substrate for Escano. The motivation for doing so would have been "for the purposes of contributing to the non-blocking characteristics and to control the smudge resistance thereof" (Column 4, lines 44-46).

Response to Arguments

Applicant's arguments with respect to claims 1-8 and 10-11 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Geoffrey Mruk whose telephone number is 571 272-2810. The examiner can normally be reached on 7am - 330pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Meier can be reached on 571 272-2149. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


STEPHEN MEIER
SUPERVISORY PATENT EXAMINER

GSM

5/25/2006

